

Remarks

Claims 1–6, 8, 9, and 11–13 are amended, claim 21 is cancelled, and new claim 25 and 26 are added. The amendments are fully supported by the specification and add no new matter to the application. For example, support for the thermoplastic packaging material having a melting temperature lower than the flow temperature of the pressure sensitive adhesive is on page 12, lines 28 to page 13, line 4.

Claims 10 and 14 are allowed.

Claims 1–6, 8–20, and 22–26 are pending.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 2–6 were rejected as being indefinite. The pending claims are definite. More specifically, claim 1 has been amended to recite a hot melt pressure sensitive adhesive. Claims 2–6 refer to the hot melt pressure sensitive adhesive of claim 1. Applicants respectfully request withdrawal of the rejection of claims 2–6 based on indefiniteness.

Further, these claims 2–6 are in a proper dependent form under 37 C.F.R. § 1.75(c). Each of these claims adds a further limitation to claim 1. Applicants request withdrawal of the objection of claims 2–6 based on improper dependent form.

Rejection under 35 U.S.C. § 102(b)

The Examiner rejected claims 2–6, 8, and 22 as being anticipated by U.S. Patent No. 4,569,960 (hereinafter “US ‘960”) issued to Blake. Applicants respectfully submit that the pending claims are not anticipated by this reference.

The Examiner appears to have repeated his previous arguments regarding this reference and to have overlooked the differences between the pending claims and US ‘960 noted by Applicants in their Request for Continued Examination. In summary, US ‘960 provides no teaching or suggestion of a pressure sensitive adhesive with an enveloping thermoplastic packaging material. Rather, this reference teaches an adhesive applied to a Kraft paper that is not an enveloping thermoplastic packaging material.

In the interest of advancing prosecution of this pending patent application, however, Applicants have further amended the claims to clarify that the thermoplastic material used to package the pressure sensitive adhesive becomes part of a hot melt pressure sensitive adhesive.

That is, the thermoplastic packaging material has a melting temperature that is lower than the flow temperature of the pressure sensitive adhesive. To be useful as a hot melt pressure sensitive adhesive (i.e., to apply the hot melt pressure sensitive adhesive to a substrate), the temperature of the pressure sensitive adhesive is raised above its flow temperature.

There is no teaching or suggestion that the pressure sensitive adhesive in US '960 is a hot melt adhesive. Rather, the pressure sensitive adhesive is coated from a solution on to a Kraft paper or carbonless paper. Further, this reference provides no teaching or suggestion that a thermoplastic material used to envelope the pressure sensitive adhesive becomes part of a hot melt pressure sensitive adhesive composition.

Applicants respectfully request withdrawal of the rejections of claim 2-6, 8, and 22 based on US '960.

Rejection under 35 U.S.C. § 103(a) over U.S. Patent No. 4,569,960 in view of U.S. Patent No. 5,787,544

The Examiner rejected claims 1-6, 8-9, and 11-23 as obvious over the combination of US '906 and U.S. Patent No. 5,787,544 (hereinafter "US '544"). Applicants respectfully submit that the pending claims are not obvious over this combination of references.

These rejected claims are not obvious over US '906 alone. That is, this reference provides no teaching or suggestion of a hot melt pressure sensitive adhesive that includes a pressure sensitive adhesive enveloped within a thermoplastic material. There is no teaching or suggestion that the thermoplastic material has a melting temperature that is lower than the flow temperature of the pressure sensitive adhesive.

The disclosure of US '544 does not overcome the deficiencies of US '906. US '544 discloses a paint composition enclosed in a flexible, polymeric pouch. As noted by the Examiner, the flexible, polymeric pouch of US '544 is used for storage purposes. The paint is emptied out of a flexible, polymeric pouch into a paint roller tray. There is no teaching or suggestion that the flexible, polymeric pouch becomes part of a hot melt pressure sensitive adhesive composition.

Thus, the combination of US '544 and US '906 fail to teach or suggest a hot melt pressure sensitive adhesive composition that includes a pressure sensitive adhesive enveloped within a thermoplastic material. Further, there is no teaching or suggestion that the thermoplastic

material has a melting temperature that is lower than the flow temperature of the pressure sensitive adhesive.

Applicants respectfully request withdrawal of the obvious rejections for claims 1–6, 8-9, and 11-23 based on the combination of US ‘906 and US ‘544.

Improper Final Rejection

Applicants respectfully submit that the final rejection was premature. The Examiner rejected the claims in the first office action after a Request for Continuing Examination was filed. MPEP § 706.7(b) provides that the claims of a new application may be finally rejected in the first office action in situations “where (A) the new application is a continuing application of, or a substitute for, an earlier application and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the Office action if they had been entered in the earlier application.”

The Examiner rejected some of the claims based on art that was not of record prior to filing the Request for Continued Examination. More specifically, the Examiner rejected claims 1-6, 8-9, and 11–23 as obvious over the combination of US ‘906 and U.S. Patent No. 5,787,544 (hereinafter “US ‘544”) issue to Meade. US ‘544 was not part of the art of record at the time the Request for Continued Examination was filed.

Further, the claims in the earlier application did not require that the pressure sensitive adhesive be enveloped in a thermoplastic packaging material. All of the independent claims were amended when the Request for Continued Examination was filed to include this additional limitation.

Applicants respectfully request withdrawal of the final rejection.

Applicants submit that the pending claims 1-6, 8-20, and 22-26 are in condition for allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

May 26, 2004
Date

By: Jean A. Lown
Jean A. Lown, Reg. No.: 48,428
Telephone No.: (651) 733-3169

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833